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Application Number	10/081,659
Filing Date	February 21, 2002
First Named Inventor	Suresh Marisetty
Art Unit	2111
Examiner Name	Glenn Allen Auye
Attorney Docket Number	42390.P2319RC

ENCLOSURES (Check all that apply)

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Remarks

** Appeal Brief in triplicate is enclosed.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	John Patrick Ward Reg. No. 40,216
Signature	
Date	June 18, 2004

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☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 330.00

Complete if Known

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Examiner Name	Glenn Allen Auve
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Attorney Docket No.	42390.P2319C

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FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

	Extra Claims	Fee from below	Fee Paid
Total Claims	-20** =	X	
Independent Claims	-3** =	X	
Multiple Dependent			

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

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Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	330.00
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility Issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

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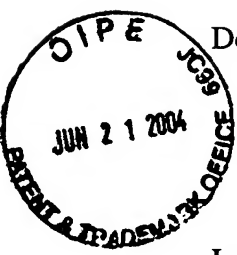
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Name (Print/Type)	John Patrick Ward	Registration No. (Attorney/Agent)	40,216	Telephone	408-720-8300
Signature		Date	June 18, 2004		

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Docket No.: 42390.P2319RC

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the application of:)
)
Marisetty)
)
Serial No.: 10/081,659) Examiner: Auve, G.
Filed: 02/21/2002)
Which is a Continuation of:) Art Unit: 2111
Application Serial No. 09/224,620)
Filed 12/31/1998)
Reissue of US Patent 5,590,342)
)
For: Method and Apparatus for Adjusting a)
Power Consumption Level Based on the)
Amount of Time a Processor Clock is)
Stopped)

APPELLANT'S BRIEF UNDER 37 CFR § 1.192
IN SUPPORT OF APPELLANT'S APPEAL TO THE BOARD OF PATENT
APPEALS AND INTERFERENCES

Hon. Commissioner of
Patent & Trademarks
Mail Stop Appeal Brief – Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant hereby submits this Brief in triplicate in support of an appeal from a final decision of the Examiner, in the above-referenced case. Appellant respectfully requests consideration of this appeal by the board of Patent Appeals and Interference for allowance of the above-referenced patent application.

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I. Real Party in Interest

The real party in interest in the present appeal is Intel Corporation of Santa Clara, California, the assignee of the present application.

II. Related Appeals and Interferences

The present Application for which this Appeal Brief is being submitted is related to the parent application, serial number 09/224,620, for which an Appeal Brief has been submitted to the Board of Patent Appeals and Interferences. Otherwise, there are no related appeals or interferences to appellant's knowledge that would have a bearing on any decision of the Board of Patent Appeals and Interferences.

III. Status of the Claims

Claims 36-90 stand rejected under 35 USC § 251 and 37 CFR § 1.175 as being based on a defective reissue declaration. Applicant has submitted herewith a new reissue declaration that remedies the alleged defects.

Claims 36-90 stand rejected under 35 USC § 251.

IV. Status of Amendments

The present reissue application for reissue of US Patent 5,590,342 (the '342 patent) was filed on 02/21/02, which is a continuation of reissue application 09/224,620 filed on 12/31/98, within the two year period of the issue date of the '342 patent, 12/31/96.

On 02/21/02, applicant filed with the reissue application in a preliminary amendment adding presently numbered claims 36 – 90 and indicated applicant's intent to broaden the claims of the reissue application..

On 8/27/02, an Office Action was mailed examining presently numbered reissue claims 36-90. In that Office Action, the Examiner rejected presently numbered claims 36-90 under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the reissue is based. Furthermore, the Examiner objected to Applicant's reissue oath/declaration for failing to identify at least one error which is relied upon to support the reissue application under 37 CFR 1.175.

On 2/26/03, Applicant submitted a revised oath/declaration citing what was believed to be at least one error relied upon to support the reissue application under 37 CFR 1.175. Particularly, Applicant cited that the attorney who prepared the application, which later became the '342 patent, failed to appreciate the full scope of the invention and cited In Re Wilder, 736 F.2d 1516, as basis for why this reason was an acceptable error upon which a reissue may be based under 37 CFR 1.175.

On 2/26/03, Applicant also submitted a response to the Examiner's rejection of

claims 36-90 under 35 U.S.C. 251 from the Office Action of 8/27/02, along with a request for an extension of time and the appropriate fee. In Applicant's response of 2/26/03, Applicant argued, for one, that because an attorney's failure to appreciate the scope of the invention was said to be proper basis for a reissue under In Re Wilder, the revised oath/declaration was sufficient to serve an error upon which an application for reissue may be based. Furthermore, Applicant argued that because addition of the limitation "virtual device driver" in the prosecution of the '342 patent does not constitute an admission that the limitation was necessary for patentability, the recapture doctrine may not be applied. Relevant cases were cited in support of this assertion by Applicant.

On 3/28/03, a notice that Applicant's response of 2/26/03 was not responsive, because a claim had been omitted without discussion.

On 5/20/03, Applicant submitted a response, which explained that the claim mentioned in the Office Action of 3/28/03 was inadvertently omitted. Accordingly, the claim was included with a list of the claims being examined.

On 6/05/03, a Final Office Action was mailed by the Examiner, in which the Examiner reiterated his objection to the oath/declaration as failing to cite at least one error upon which a reissue application may be based. Furthermore, the Final Office Action reasoned, essentially, that because the reissue claims no longer contained the limitation, "virtual device driver", and because, in the Examiner's view, no other materially narrow limitation had been added in its place, claims 36-90 were rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter surrendered in the application for the '342 patent, upon which the reissue is based.

On 8/27/03, Applicant responded to the Final Office Action of 6/05/03 along with

a Request for Continued Examination and reiterated that failure of an attorney to appreciate the scope of the invention was acceptable error under 37 CFR 1.175, and provided supporting cites from the MPEP. Furthermore, Applicant argued that in view of a Precedential Opinion, Ex parte Danial M. Eggert and Frank Mikic, Decided May 29, 2003 (“Eggert”), the Examiner may not reject reissue claims under the recapture doctrine merely because a limitation was removed from the parent application allegedly relied upon for patentability in the prosecution of the parent application. Finally, Applicant reiterated his argument that reissue claims are narrower than the those of the parent in a manner material to the surrendered matter and therefore the recapture doctrine should not apply.

On 9/23/03, an Office Action was mailed in which the examiner reiterated his objection to the oath/declaration as failing to cite at least one error upon which Applicant relies in support of the reissue application under 37 CFR 1.175. Particularly, the Office Action cited MPEP §1414(II), in which it states that “...**it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in the original claim...**”, “**..the oath/declaration must specifically identify an error.**”, and “**any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.**” (emphasis added by Examiner). Furthermore, the Office Action reiterated the rejection of claims 36-90 on the same grounds as in the Final Office Action of 6/05/03. Additionally, the Examiner responded to Applicant’s assertions in Applicant’s response of 8/27/03 regarding the Precedential Opinion, Eggert. Specifically, the Examiner proffered his interpretation of Eggert, which was that although Eggert says there is no per se rule barring claims

eliminating limitations relied upon for patentability, Eggert appears to rely on the three part test of Clement and Pannu, upon which the Examiner based his rejection of claims 36-90.

On 12/22/03, Applicant responded to the Office Action of 9/23/03 with an Amendment and an updated oath/declaration. The oath/declaration was updated to reflect that the original claims contained a limitation, “device manager”, which unduely narrowed the claims from that which Applicant was entitled to claim in view of the prior art, due to the attorney’s failure to appreciate the scope of the invention. Furthermore, Applicant argued in response to Examiner’s rejection of claims 36-90 that requiring a reissue applicant to materially narrow a claim containing recaptured matter in order to escape the recapture doctrine is counter to the intent of the broadening reissue statute, 35 U.S.C. 251.

On 1/29/04, a Final Office Action was mailed in which the Examiner objected to the oath/declaration based on Applicant’s assertion in the response of 12/22/03 that the claims of the original patent are limited to a “device manager”. The Examiner rightly noticed that the claims of the original patent were limited to a “device driver” not a “device manager”. Furthermore, the Final Office Action reasserted the rejection of claims 36-90 for the same reasons indicated in earlier Office Actions.

On 4/21/04, Applicant filed a Notice of Appeal and included a corrected oath/declaration in which Applicant states that the original claims are limited to a “virtual device driver”, which is an error relied upon by Applicant as a basis for the reissue application under 37 CFR 1.175.

V. Summary of the Invention

Appellant's disclosure describes a system, method, apparatus, and computer program product related to power management of multiple and/or configurable devices. In one embodiment, the invention overcomes the shortcomings of prior art dedicated device driver software power management solutions as well as operating-system-transparent microcontroller-based solutions by utilizing a software solution with appropriate capabilities to accommodate devices with variable configurations. Operation-system-transparent hardware-based solutions of the prior art simply lacked the ability to adapt to and be informed of changes in configurations of devices in a manner allowing power management of those devices to effectively continue. Additionally, typical dedicated prior art device drivers were just that, dedicated. Such dedicated device drivers did not power manage multiple devices, much less multiple configurable devices.

VI. Issues

1. Does the recapture doctrine bar any broadening of a claim beyond a limitation that was added to overcome a prior art rejection, meaning that the reissue claim may not exclude the precise limitation that was added to overcome prior art in the original patent?

2. Did, applicant “surrender” any and all subject matter that lacks the “virtual device driver” limitation?

3. Does the recapture doctrine bar the independent claims?

4. Is the Judicially Created Recapture Doctrine inherently and irreconcilably inconsistent with the Reissue Statute, 35 USC § 251, which permits broadening of claims, and now devoid of its original purpose of ensuring comity to the prosecution-history-reading public?

5. Is the Failure of an Attorney to Appreciate the Scope of the Invention Alone Sufficient Error upon which the Applicant may rely as a Basis for a Broadening Reissue?

VII. Organization of Claims

For the purposes of this appeal only, the independent claims stand or fall together and therefore will be discussed as a group hereafter referred to as “the independent claims”. Dependent claims not specifically discussed herein are assumed to stand or fall with the independent claims from which they are dependent.

VIII. Argument

Recapture analysis under current law is a multiple part analysis. As a threshold issue, it appears that the Examiner is taking the position that a limitation added in prosecution to overcome a reference simply must appear in all reissue claims. Although the applicable precedent may be somewhat confusing, this is wrong as appellant shows immediately below. Next, because an **admission** that subject matter is not patentable, may not constitute the “error” contemplated under the reissue statute, appellant shows that indeed appellant did not admit that appellant is not entitled to claims unless they recited the words “virtual device driver”. The record contains no such admission. Since the traditional recapture doctrine bars obtaining claims of the **same** scope as those canceled to obtain allowance of the original patent, appellant shows why the present reissue claims are not of the same scope, but rather are each narrower in at least one material respect than the claim surrendered in obtaining the ‘342 Patent.

Finally, appellant argues that the recapture doctrine itself is flawed. The doctrine designed to provide the public with safe harbors of operation is now so muddled that the public cannot possibly rely on recapture with any degree of certainty. The only

limitations on a broadening reissue should be the prior art, the two year statute of limitations imposed by 35 USC § 251, and the requirement that the error be an error without deceptive intent.

1. Does the recapture doctrine bar any broadening of a claim beyond a limitation that was added to overcome a prior art rejection, meaning that the reissue claim may not exclude the precise limitation that was added to overcome prior art in the original patent?

A. Narrowing Amendment not an Absolute Bar to Removing/Altering Limitation

Although originally not codified in statute, the ability to broaden a patent through reissue is a cornerstone of US patent system. The Supreme Court first spoke on the issue by striking down an attempt to enforce a broadened reissue claim in Miller v. Brass, 104 US 350 (1881). Although the Court struck down the reissue due to the unreasonable delay of 15 years in filing the reissue, Justice Bradley noted that “under general terms of law, such a reissue may be made where it clearly appears that an actual mistake has inadvertently been made.” Miller, 104 US 350, 355.

In contrast, Topliff v. Topliff, 145 US 156 (1892), held a lapse of less than two years ordinarily will not be evidence of an abandonment by the patentee so as to bar him from obtaining a broadening reissue. Topliff, 145 US 156, 170. As in Miller, Justice Bradley reaffirmed the notion that when a patent is inoperative due to the claims being narrower than the actual invention of the patentee, and the error has arisen inadvertently or by mistake without fraud or deception, the patentee may seek a broadening reissued patent if he is diligent in discovering the mistake. The ability to file for such a

broadening reissue within two years of the date of patent issuance was later codified in 35 USC § 64 in 1946 and then in 35 USC § 251 in its present form in 1952.

The reissue statute is grounded in the principle, articulated by Chief Justice Marshall, in Grant v. Raymond, 31 U.S. (6 Pet.) 218, 244 (1832), that a defective patent is an inadequate exchange for the patentee's disclosure of an invention and that a new patent should be issued, in appropriate circumstances, which secures to the patentee the benefits which the law intended. Hewlett-Packard Co. v. Bausch & Lomb, Inc., 882 F.2d 1556, 1565 (Fed. Cir. 1989). "The reissue statute balances the purpose of providing the patentee with an opportunity to correct errors of inadequate claim scope against the public interest in finality and certainty of patent rights." In re Graff, 111 F.3d 874, 877 (Fed. Cir. 1997). The statute is remedial in nature, based on fundamental principles of equity and fairness and, therefore, to be construed liberally.

The "recapture" doctrine, on the other hand, was never codified. The recapture doctrine is directly at odds with the broadening reissue statute because recapture limits the ability of an applicant to seek broadened claims. The recapture doctrine, in effect, limits the ability to remedy errors, and therefore should be at least narrowly construed if not abandoned altogether. Arguably, the recapture doctrine simply defines "error" as used in the statute; however, in any case, it is clear that recapture limits the ability, explicitly provided by Congress in 35 USC § 251, to obtain broader claims in a reissue patent. Again, a narrow construction of any such doctrine is appropriate since recapture operates directly against the statute itself.

The recapture doctrine grew out of the Supreme Court's decision in Leggett v. Avery, 101 US 256 (1879). Once again, Justice Bradley, speaking for the majority

invalidated a reissue patent that sought to claim matter explicitly surrendered to obtain the original patent. Specifically, the patentee in Leggett canceled a number of claims at the request of the examiner in order to obtain a patent extension. Later, the patentee re-applied for a term extension. Because the claims were abandoned in order to secure the reissue extension, the Court held that the patentee was estopped from subsequently reclaiming them.

Leggett became the basis of what is now considered the recapture doctrine. Various cases discuss principles of estoppel, and others rely on the meaning of “error” in the modern reissue statute as bases for preventing recapture. Although the Federal Circuit evinces a tightening grip on claim scope, none of the cases go so far as the Examiner in this case now insists. Such an extension of the recapture doctrine is contrary to the modern precedent, historical development, not to mention the reissue statute itself.

After the 1952 Patent Act, numerous cases re-examined the notion of “error” due to the fact that the new statute eliminated the terms “inadvertence, accident, or mistake” from the error requirement. Under the ’52 Act, the only requirement on “error” is that the error occur “without deceptive intent”. Although there was some disagreement,¹ the cases generally reasoned that there was no practical effect to the change, and the jurisprudence generally previously applied in determining error remained valid precedent. The modern cases also clearly demonstrate that recapture is a slight conscription on what may be claimed in a reissue patent.

For example, In re Byers, 230 F.2d 451 (CCPA 1956) stands for the proposition that the same claims or claims broader in all respects than those originally canceled cannot be obtained by reissue. The Court in Byers couched its analysis mostly in terms

of whether or not the applicant committed an “error” correctable under the reissue statute.

The Court reasoned that the reissue claims were **only** broader and not **in any manner** narrower.

A comparison of the claims makes it clear that appealed claims 2 and 3 are drawn to the same invention as was original claim 20 of appellant's original application, and that they are broader in certain respects and **not narrower in any respect** than that claim.
Byers, 230 F.2d 451, 455 (emphasis added).

The Court emphasized the historical development of the doctrine

It is well settled that the deliberate withdrawal or amendment of a claim in order to obtain a patent does not involve inadvertence, accident or mistake and is not an error of the kind which will justify a reissue of the patent including the matter withdrawn. Thus in Dobson v. Lees, 137 U.S. 258, the Supreme Court of the United States said:

A reissue is an amendment, and cannot be allowed unless the imperfections in the original patent arose without fraud, and from inadvertence, accident or mistake. * * * Hence the reissue cannot be permitted to enlarge the claims of the original patent by including matter once intentionally omitted. Acquiescence in the rejection of a claim; its withdrawal by amendment, either to save the application or to escape an interference; the acceptance of a patent containing limitations imposed by the Patent Office, which narrow the scope of the invention as at first described and claimed; are instances of such omission.

Similarity in Shepard v. Corrigan, 116 U.S. 593, the Court said:

Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent.

The rule set forth in those cases has been repeatedly applied by this court. In re Murray, Jr., 20 C.C.P.A. (Patents) 1046, 64 F.2d 788, 17 U.S.Pat.Q. 365; In re Guastavino, 23 C.C.P.A. (Patents) 1179, 83 F.2d 913, 29 USPQ 532; In re Crowell, 23 C.C.P.A. (Patents) 725, 79 F.2d 746, 27 USPQ 349; In re French, 24 C.C.P.A. (Patents) 1218, 90 F.2d 113, 33 USPQ 537; In re Stanton, 86 F. 2d 337, 24 C.C.P.A. (Patents) 708, 31 USPQ 336; In re Lane, 32 C.C.P.A. (Patents) 817, 146 F.2d 306, 64 USPQ 231.
Byers, 230 F.2d 451, 455-6.

The Court made it clear that simply “dropping” such an added element in a reissue, without more, was impermissible. This proscription **only** applies to claims of the same scope or of broader scope in all regards.

It is evident that since the deliberate cancelation of a claim in order to obtain a patent constitutes a bar to the obtaining of **the same claim** by reissue, it necessarily also constitutes a bar to the obtaining of a claim which differs from that canceled **only in being broader**.

¹ See, e.g., concurring opinion in In re Wadlinger, 496 F.2d 1200, 1209-11.

That was the holding in In re White, 23 F.2d 776, 57 App.D.C. 355, and in In re Murray, supra, this court quoted with approval the following statement from Ex parte White 1928 C.D. 6:

The deliberate withdrawal of a claim in order to secure a patent is conclusive of the presumption that there has been no inadvertence, accident, or mistake, and the invention thus abandoned cannot be regained either by construing the claims of the patent broadly or by obtaining a reissue with broadened claims. The rule is the same whether the claims sought by reissue or otherwise are **identical, substantially the same, or broader than** the abandoned claims.

Byers, 230 F.2d 451, 455 (emphasis added).

Thus, Byers only addressed the cases of broadened-in-all-respects claims and claims of the same scope as those previously canceled. Subsequently, in In re Wesseler, 367 F.2d 838, the Board took exactly the same position that the Examiner in this case is now taking, and lost. Wesseler dealt with a claim which was amended to specify additional detail about a mounting means (an “offset ear”) for a cable or pipe hanger. The Board took the position that the Examiner in that case had effectively stated that the claim would not be allowable without the “offset ear” mounting means limitation.² Wesseler, 367 F.2d 838, 844. The Court disagreed and stated that under the facts of the prosecution history no admission on the part of the applicant or affirmative statement on the part of the Examiner established that the claims could only be patented with this limitation. Wesseler, 367 F.2d 838, 850.

The Board acknowledged that the reissue claims were not of the same scope as the surrendered claims. Wesseler, 367 F.2d 838, 844 (“Nowhere have we held that any of the claims that we have rejected on the ground of lack of error are of the same scope as claims cancelled during prosecution in the original application. This was not our ground

² In the present reissue application, the Examiner does not even take as strong of a position as in Wesseler. In Wesseler, the Examiner at least argued that the prosecution history amounted to a statement that the claims would not be patentable without the mounting means limitation. Here, it is clear that the record makes no such affirmative statement that the virtual device driver limitation is necessary. Without such statement, it simply is not recapture to reissue a claim with a *different* scope that omits the virtual device driver limitation.

of rejection, and we recognize that all of the claims before us contain terms of recitation that are added limitations not present in the cancelled claims”). The Board nonetheless took the position that once a limitation was added, it could not be removed. The Court soundly rejected these arguments

Furthermore, the Court clarified that in Shepard v. Carrigan, it was the prior art which prevented the applicant from obtaining broader claims without certain limitations. Wesseler, 367 F.2d 838, 849. The Court also distinguished Miller v. Brass as involving the applicant trying to again claim “the very thing which the patentee professed to avoid and dispense with” (i.e., there was a clear disclaimer of that subject matter). Wesseler, 367 F.2d 838, 849-50.

Even more on point is In re Petrow, 402 F.2d 485 (CCPA 1968). In Petrow, the Court reasoned that there were insufficient facts in the record to hold that appellants' cancellation was an admission that their new claim was not patentable at the time the earlier claim was canceled. Thus, appellants were not estopped from obtaining the new claim of different scope through reissue if that claim **differed immaterially** from the surrendered claims. The Court pointed out that the inquiry is governed by the facts of each case.

We think it well to state at the outset that we are guided herein by the language in In re Willingham, 48 CCPA 727, 282 F.2d 353, 127 USPQ 211, where this court observed:

The deliberate cancellation of a claim of an original application in order to secure a patent cannot ordinarily be said to be an "error" and will in most cases prevent the applicant from obtaining the cancelled claim by reissue. **The extent to which it may also prevent him from obtaining other claims differing in form or substance from that cancelled necessarily depends upon the facts in each case and particularly on the reasons for the cancellation.**

Petrow, 402 F.2d 485, 487 (emphasis added).

Thus, Petrow made it quite clear that as long as a claim differs immaterially from a canceled claim, it is not barred merely by omitting some limitation added in

prosecution.

Additionally, In re Richman, 409 F.2d 269 (CCPA 1969), further brings home this point. Again, the board argued that there was precedent for the proposition that once a limitation is added, it cannot be broadened or removed. This position was flatly rejected. In fact, the Court indicated that the inquiry was completely wrong. There is in fact no reason to question whether a claim contains a particular limitation. The necessary inquiry is whether the claim is of the **same** scope. The Court stated:

In support of his position, the solicitor points out that this court, in In re Wesseler (supra, footnote 3), stated that Shepard v. Carrigan, 116 U.S. 593 (1886), "may be support for the rule that one who deliberately adds a limitation to avoid the prior art cannot omit that limitation in reissue claims so as to encroach upon the prior art * * *." Referring back to Shepard, however, it is apparent that the situation there was one in which the omission of the added limitation would have resulted in the claim being drawn to the same subject matter as the original rejected claim, to which the limitation was added, thus making it unpatentable over the prior art for the same reason as the original claim. **We therefore find neither decision to be authority for the proposition that a limitation added to a claim in obtaining its allowance cannot be broadened, under present statutory law, by reissue if the limitation turns out to be more restrictive than the prior art required.** Certainly one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art. Richman, 409 F.2d 269, 275 (emphasis added).

The Court made very clear that the scope of estoppel is very limited, and indeed only estops the recapture of subject matter of the same scope as the canceled claims. The Court also clearly indicated that it was possible to err without deceptive intent by narrowing claims too much.

It is thus' apparent that each of the appealed claims **is more restrictive in at least one significant respect** than the cancelled claims and that **appellant is not seeking**, through the presentation of claims 23-28, **to recapture the same subject matter that he sought in cancelled claims 1-15.** We find no basis for estoppel. Neither do we find any evidence that appellant intended to settle for less protection than he was entitled to or to omit or abandon the subject matter he seeks here. We do find, as in Wesseler, that "while appellant acted 'deliberately', he did so in error." The error, so far as the facts of record are concerned, can only be regarded as "error without any deceptive intention" within the terms of 35 USC 251. Richman, 409 F.2d 269 at 276 (footnote omitted) (emphasis added).

Thus the law is and remains that as long as the reissue claims are narrower in at least one "significant" or "material" respect, and as long as no intent to surrender such

claims is shown by the prosecution history, the recapture doctrine does not bar such claims. Richman was cited approvingly in the more recent CCPA and Federal Circuit cases on this issue. See, e.g., In re Clement, 131 F.3d 1464, 1468 (Fed. Cir. 1997); Ball Corp. v. United States, 729 F.2d 1429, 1436 (Fed. Cir. 1984); In re Wadlinger, 496 F.2d 1200, 1208 (C.C.P.A. 1974). In fact Wadlinger concisely addressed the point by stating “[t]his court, in its decisions both before and after Wesseler, has made it clear that a reissue applicant is, **at most**, prevented by interpretations of the language of § 251, and its predecessor statute R.S. 4916, from obtaining claims which are of the same scope as the claims previously cancelled in the original application.” Wadlinger, 496 F.2d 1200, 1207 (emphasis added).

The more recent cases of discuss ways to determine if recapture has occurred, but again the standard is whether a material limitation beyond the canceled claim has been added.³ For example, Ball Corp. v. United States, 729 F.2d 1429 (Fed. Cir. 1984), illustrates that a limitation added in prosecution of a patent may be removed through reissue. In Ball, although the patentee amended a “feed means” limitation to include a specific limitation, the Federal Circuit upheld claims that modified and broadened the exact element added. To obtain allowance of the original patent, the patentee added “a plurality of feedlines”. In a disputed reissue claim, the patentee removed a “substantially cylindrical conductor” limitation and broadened the “plurality of feedlines” limitation to “at least one conductive lead”. This term is broader than the added “plurality of feedlines” in two regards. First, the term “at least one conductive lead” encompasses one conductive lead, whereas “a plurality of feedlines” requires two or more items. Secondly,

³ Appellant addresses the issue of whether the claim of different scope was also surrendered through the prosecution history below.

the claim is broader because the term “conductive lead” is substituted for “feedline”. The claim escaped the recapture doctrine as being narrower, on balance, with respect to the feed means aspect. Thus, under Ball, even though a term added in prosecution was not used verbatim in the reissue claims, and even though the term was broadened, the claim was upheld.

In Mentor Corp. V. Coloplast, Inc., 998 F.2d 992 (Fed. Cir. 1993), the Federal Circuit again indicated that a claim *might* escape the recapture doctrine even though it eliminated limitations added during prosecution. The reissue claim at issue in Mentor eliminated a limitation that an adhesive be transferred from an outer to an inner layer, and therefore was broader in terms of the very aspect that was narrowed to obtain allowance of the original patent. Again, the court entertained arguments that the claim may escape recapture if it included other materially narrowing limitations. However, the court held that the limitations that were added were insufficient. The court held that the added “flexible” and “single roll” limitations were not materially narrowing limitations. Thus, the claim did not escape the recapture prohibition:

The limitation in claim 6 that the catheter material be “flexible” did not materially narrow the claims, which already recited that the material be “resilient.” Likewise, the limitation that the catheter be rolled outward to form a “single” roll did not materially limit the claims; the catheter can only be rolled and applied from a single end to form a single roll when the other end is connected to a urine collection means. Further, the addition of the words “thereon,” referring to the location of the adhesive release layer on the outer surface prior to unrolling, and “only,” referring to the adhering of the adhesive to the inner surface after unrolling, did not materially narrow the claims.
Mentor, 998 F.2d 992, 996.

Thus, the Mentor Court found “flexible” to not be a material limitation of a catheter that is already claimed to be “resilient” since a resilient catheter is also inherently somewhat flexible. Additionally, the Court did not find the “single” limitation to be materially limiting as it was inherently required by the remainder of the claim.

Additionally, the use of “thereon” and “only” were simply deemed to not materially limit the claims. Thus, the Mentor decision indicates that already-inherently-required limitations are not materially limiting. As detailed below, applicant has added truly limiting additional limitations to applicant’s reissue claims.

Similarly, in Hester, the Federal Circuit again took the position that a claim might escape recapture despite covering some subject matter which was previously deemed surrendered. In Hester, the court concluded that Williams had surrendered, by argument, subject matter lacking the “solely with steam” and “two sources of steam” limitations. Yet, the court acknowledged that the recapture doctrine may be avoided even though surrendered subject matter had crept back into the reissue claims. Hester, 142 F.3d 1472, 1482 (“Finally, because the recapture rule may be avoided in some circumstances, we consider whether the reissue claims were materially narrowed in other respects. See, e.g., Mentor, 998 F.2d at 996, 27 U.S.P.Q.2D (BNA) at 1525 (“Reissue claims that are broader in certain respects and narrower in others may avoid the effect of the recapture rule.”); Clement, 131 F.3d at 1470, 45 U.S.P.Q.2D (BNA) at 1165.”).

Again, however, in Hester, the Court was unconvinced that any material limitations had been added. In Hester, the term “high humidity steam” was determined to not qualify as a materially narrower term because it was actually broader than the limitation in the original claim than the term replaced. Hester, 142 F.3d 1472, 1483. Also, in Hester, the term “spiral conveyance path” was found to be not materially limiting because claim 1 already contained a corresponding element. Claim 1 contained a means plus function element, and the only corresponding structure passed the conveyor through a spiral path. Hester, 142 F.3d 1472, 1483. Therefore, this “limitation” was found to not

be a limitation at all. Any difference was immaterial. Furthermore, Hester failed to explain how the recitation of this element, which was present in prior art cookers cited by the Examiner during prosecution of the original patent, materially narrowed the claims.

Other courts have successfully applied this “materiality” standard to reissue claims. The District Court in Sonoco Prods. Co. v. Durabag Co., 1994 U.S. Dist. LEXIS 18443 (DC CD Cal 1994) ruled that claim differences were not sufficiently material to clear the recapture hurdle. A “tab means” that was added to the claim was deemed not sufficiently material because the “tab means” limitation was contained in several of the canceled claims of the original patent and because the Examiner deemed claims containing the tab means to be obvious. In other words, the tab means were deemed by the Examiner in the original case to be obvious in view of the prior art, and their addition was therefore immaterial.

On the other hand, in B.E. Meyers & Co. v. United States, 47 Fed. Cl. 200 (Fed. Cl. 2000), the Court found that a reissue application did not violate the recapture rule. The original application recited a pulsing circuit, which was narrowed to avoid the prior art. The reissue claims related to a lens apparatus that produced a beam with a well-defined peripheral edge. The Court found that the lens apparatus was in fact a separate invention eligible for patent protection, independent of whatever type of pulsing circuitry might be used in combination with the lens system in any particular device. In order to receive protection for this aspect of its invention, the applicant had to delete any reference to pulsing circuitry in the reissue claims. Of course, in doing so, the applicant deleted the specific pulsing diode and substantial pulsing current limitations that had been added to its original claim to distinguish the prior art. Thus, Meyers demonstrates that a different

invention, absent the limitations added to obtain allowance of the patent, may be obtained via reissue.

More recently, the Federal Circuit has once again condoned the material-narrowing-avoids-recapture approach in Pannu v. Storz Instruments, Inc., 258 F.3d 1366, 1371 (Fed. Cir. 2001) (“Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule. Hester, 142 F.3d at 1482-83, 46 U.S.P.Q.2D (BNA) at 1649-50; Clement, 131 F.3d at 1470, 45 U.S.P.Q.2D (BNA) at 1165.”). In Pannu, the patentee added a limitation to the shape and positioning to the haptics during prosecution of the original patent. Specifically, the new claim stated that the haptics would contain "a continuous, substantially circular arc having a diameter greater than the diameter of said lens body." In the reissue patent, the Patent Examiner allowed the removal of this very limitation, but had the patentee include certain changes, including size limitations, where the snag resistant means would be at least three times greater than the flexible elements, and the supporting elements would be substantially coplaner with the haptics.

The Court in Pannu did not dismiss out of hand Pannu’s claims due to the lack of the “continuous, substantially circular arc” limitation. Rather, the Court continued on to determine whether the other added limitations were material. In this case, the Court did not find that the limitations were sufficient to avoid recapture, stating that the “reissued claims were not narrowed in any material respect compared with their broadening.” Pannu, 258 F.3d 1366, 1371. However, it is clear that an analysis of whether materially limiting new elements were added was performed to decide whether Pannu could

recapture some of the subject matter he gave up.⁴ Unfortunately, and incorrectly, the Examiner in this case seems to believe that no limitations will save a claim if it is missing something that was added in prosecution of the original application.⁵

In summary, it is abundantly clear that the mere addition of a limitation to a claim does not absolutely preclude that limitation from being removed via reissue. There is simply no requirement that applicant can not take out what was put in to obtain allowance, assuming that other material narrowing limitations are added. Similarly, argument cannot have such preclusive effect either. See, e.g., Hester, 142 F.3d 1472.

B. Appellant's Reissue Claims

The comments in this section are made with regard to Applicant's original Reissue claims contained in Application Serial No. 09/224,620, currently on Appeal with the Board of Appeals and Interferences. Although appellant added the term "virtual" to claim 11, this addition does not bar removal of this term. Applicant did not admit that

⁴ Somewhat confusingly, Pannu also states "In prosecuting the '855 patent, Pannu specifically limited the shape of the haptics to a "continuous, substantially circular arc." On reissue, he is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections." Pannu, 258 F.3d 1366, 1371. This quote, taken out of context may seem to indicate that a patentee cannot recapture any of what was surrendered in prosecution of the original patent. However, taken in context, this is only a statement that based on the facts of this case, Pannu is estopped from recapturing what he attempted to recapture. This is not a blanket statement that all patentees are estopped from recapturing anything they surrendered. Such a bold holding would clearly overrule numerous prior cases, including Ball, Mentor, and Hester, just to name a few. Any interpretation that assumes the Federal Circuit has overruled well established precedent *sub silentio* and by a panel decision is clearly erroneous. As further discussed below, additional criteria, such as whether a limitation is germane to a prior art rejection may be a useful tool for analysis of its materiality in some cases. These additional criteria are not required nor particularly instructive in other cases.

⁵ The Examiner appears to take precisely the opposite position as the case law, which allows some material narrowing to save a claim broadened to remove a limitation added in prosecution. On p. 7 of the Office Action of 4/2/02, the Examiner states:

As noted above, the Court in Pannu explicitly stated that on reissue applicant is estopped from attempting to recapture the precise limitation he added to overcome the prior art rejection. That is what applicant is attempting to do in this case.

this term was required to overcome the prior art nor that it was the only way to overcome the prior art.

Claim 11 was amended as shown by the underlined portions below:

11. A computer system comprising:

a bus;

a central processing unit (CPU) coupled to the bus running an operating system and at least one power-unaware application, wherein the operating system has a virtual device driver performing device idle detection using one or more events timers indicating the activity level of at least one local device, and further wherein the virtual device driver places idle local devices in a reduced power consumption state when associated events timers indicate that no activity has occurred for a predetermined period of time transparent to said at least one power-unaware application.

In the first Office Action issued by the patent office, claims 12-15 were rejected under 35 USC § 112, second paragraph for improper antecedent basis. Claims 12-15 originally depended on claim 11 and originally contained the term “virtual device driver”, unlike the parent claim 11 which originally only contained the term “device driver”. Appellant amended claim 11 to include the “virtual device driver” limitation, thereby overcoming the rejection of claims 12-15 under 35 USC § 112, second paragraph.

Additionally, the Examiner suggested that the “virtual device driver” limitation justified the grant of a patent. Office Action mailed 1/26/96, p. 6 (“Independent claim 1 is similar to claim 11, except that it specifies the use of *virtual* device drivers to provide power control over devices, instead of using the normal devices drivers of claim 11. As virtual device drivers have no permanent tie to specific hardware, their use in controlling power to specific hardware is considered a novel departure from normal methods of power control.”) (emphasis in original).

Applicant did not disagree. Indeed, applicant continues to agree that this limitation justifies the patentability of such claims. Applicant re-iterated the Examiner’s observation with respect to claim 11 that the references Smith (US Patent 5,167,024),

Stewart (US Patent 5,404,546), Kardach (US Patent 5,276,888), Mattox (US Patent 5,404,321) do not disclose the use of virtual device drivers. Response Dated 5/28/96, p. 6. Applicant noted that the same argument applied to claims 21-35 but did not amend these claims and never responded to any art rejection of these claims.

At most, the record can be taken to indicate that Applicant agreed with the Examiner that the feature “virtual device driver” was one way to distinguish the prior art. An independent justification of appellant’s amendment is that it solved a § 112, second paragraph problem in three other claims. Appellant did not repeatedly harp on the virtual device driver as being critical or important to the invention, but rather merely agreed with the Examiner that the entire combination set forth in the claims was patentable. This was not an admission that there was nothing patentable in applicant’s disclosure except inventions including a virtual device driver. Such an interpretation would be a grave distortion of the record. To so directly contravene the remedial reissue statute’s explicit error-correcting provision, surely a greater showing is required to conclude that such an admission has been made.

Once again, it is worth emphasizing that applicant clearly is not attempting to claim precisely what was surrendered (original claim 11 without the “virtual” adjective describing “device driver”). Applicant did not previously present any of now-presented reissue claims. Nor did applicant deliberately withdraw or amend any of the now-presented reissue claims. Applicant is not merely trying to re-claim the use of “normal device drivers” to perform power management.

C. Applicant’s Continuation Reissue Claims

The comments in this section are made with regard to the claims of the present Continuation of the parent Reissue Application. Although Applicant has significantly rewritten the claims in relation to those of the parent Reissue Application and of the '342 Patent, the independent claims are actually narrower in at least one material respect in relation to the omitted term, "virtual device driver". Particularly, the independent claims each recite specific functions that may be performed by a virtual device driver, thereby narrowing the claims in respect to the limitation "virtual device driver".

Applicant agrees with the Examiner that the removal of "virtual device driver" from the independent claims is a broadening in scope of the claims. However, the addition of other limitations, such as those pertaining to determining a power consumption state by determining the amount of time a clock is stopped, is a narrower limitation than the term "virtual device driver". Furthermore, since determining a power consumption state by determining an amount of time a clock is stopped, for example, is a specific function that can be performed by a virtual device driver, the claims are actually narrower in a manner material to the term "virtual device driver".

Perhaps the point of what is materially limiting is best described in terms of potential infringers. A claim that merely recites the use of a "virtual device driver" to detect an activity level of a processor as in claim 11, for example, would be able to be read on a much broader spectrum of alleged infringers than a claim limited to a specific manner in which an activity level of a processor is to be detected. For example, a virtual device driver could detect the activity level on the bus of a processor, detect the current it consumes, the heat it generates, the electromagnetic fields emanating from it, and so forth. However, an infringer of the independent claims must detect a period of time in which the

clock of the processor is stopped (among other things) in order to infringe.

C. The Examiner's Position

The Examiner appears to take the position that because a limitation was added in prosecution, this limitation cannot be removed or altered by a reissue. This is simply wrong.

The Examiner quotes a form paragraph from MPEP § 1412.02, stating:

Claims 36-90 are rejected under 35 USC § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 USC § 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

To the extent that this form paragraph can be read to take the position that a reissue cannot remove or alter a limitation which is added during prosecution of a patent, it too is flatly wrong. Notably, the paragraph need not be read in this manner because this paragraph can be read to only preclude recapturing that which was surrendered. As previously discussed, the “surrendered” subject matter is typically the original claims.

The Examiner further argues that under Pannu, the limitations added to the reissue claims are not materially limiting in relation to the recaptured limitations without providing any basis for this assertion. The Examiner acknowledged applicant's attempts to point out materially narrowed aspects of applicant's claims:

It is submitted that the presence of the power management module or instruction limitations that measure the amount of time the processor has its clock stopped and reduce the voltage level applied to a processor as a result of the measuring in the reissue claims are not a material narrowing of the surrendered subject matter with respect to the prior art rejection. Office Action of 01/29/2004, pg. 5.

However, the Examiner concluded that Pannu simply precluded allowance of claims without the “virtual device driver” limitation, stating:

In Pannu the court found that “The narrowing aspect of the claim on reissue, however, was not related to the shape of the haptics, but rather to the positioning of dimensions of the snag resistant means.” That court decided that this fact meant that “The reissued claims were not narrowed in any material respect compared with their broadening.” **Such a statement also applies to reissue claims in the present case in that any narrowing is with respect to the time determining and processor voltage reducing, not to the driver doing the controlling.**

While it is true that based on the facts of Pannu, it was found that the claim was not materially narrowed, under the interpretation of Pannu by the Examiner it could hardly be imagined under what circumstances a limitation could be added that was materially narrowing with respect to the recaptured limitation. Specifically, the Examiner appears to say in the above passage that because the added limitations only relate to the added limitations, they cannot relate to a virtual device driver. In other words, the Examiner essentially appears to reason that under Pannu, for a recaptured limitation, “X”, any added limitations must include “X + Y”, where “Y” is a new portion of the added limitation. This is not only illogical, as there would be no need to add new limitations if “X” were still present in the reissue claims, but it is an overly broad reading of Pannu.

Indeed, the Federal Circuit was forced to engage in an analysis of the allegedly narrowed claims in that case. The Court examined whether the newly introduced limitation was material. The Court did not simply dismiss Pannu’s argument because the added-in-prosecution language was now missing from the reissue claim.

In fact, such a blanket statement was not given because it would be directly contrary to other established precedent. In Ball, the court stated:

The 1952 revision of the patent laws made no substantive change in the definition of error under section 251. While deliberate cancellation of a claim cannot ordinarily be considered error, the CCPA has repeatedly held that the deliberate cancellation of claims may constitute error, if it occurs without deceptive intent. In *In re Petrow*, the CCPA went so far as to state that error is sufficient where the deliberate cancellation of claims does not amount to an

admission that the reissue claims were not patentable at the time the original claims were canceled. Similarly, in *In re Wesseler*, the CCPA stated that error is established where there is no evidence that the appellant intentionally omitted or abandoned the claimed subject matter. Thus, the CCPA has construed the term error under section 251 broadly. Ball, 729 F.2d 1429, 1435-1436 (footnotes omitted) (underlining added).

In fact, the Federal Circuit specifically eschewed a stricter standard and adopted the liberal standard of the CCPA. The Ninth Circuit had previously applied a standard substantially the same as that which the Examiner is attempting to apply to the present case. Namely, the Ninth Circuit once used a standard that precluded removing by reissue a “chief element” added in seeking the original patent. The Federal Circuit flatly rejected this standard.

The Ninth Circuit employed a more rigid standard in *Riley v. Broadway-Hale Stores, Inc.* stating: “when the chief element added by reissue has been abandoned while seeking the original patent, the reissue is void.” The trial judge sought to determine whether Ball had made a deliberate judgment that claims of substantially the same scope as the new reissue claims would have been unpatentable. The Government, arguing from *Riley*, submits that the trial judge’s approach loses sight of the feature given up by a patentee in order to secure the original patent. We decline to adopt the rigid standard applied in *Riley*, in favor of the more liberal approach taken by the CCPA. *Petrow* clearly establishes the vitality of the standard employed by the trial judge under this court’s precedent. Ball, 729 F.2d 1429, 1436.

Ball clarified that the permissible scope of the claims necessarily depended on the facts of a particular case.

In *Willingham*, the CCPA reversed the rejection of a claim that was narrower than the canceled claim as to one element, although broader as to another element. “The extent to which [deliberate cancellation of a claim from the original application] may also prevent [a patentee] from obtaining other claims differing in form or substance from that cancelled necessarily depends upon the facts in each case and particularly on the reasons for the cancellation.” *Willingham*, 282 F.2d at 357, 127 USPQ at 215. Ball, 729 F.2d 1429, 1438.

Thus, appellant contends that current law does not prevent the applicant from removing language added in prosecution and modifying the scope of the claim in a manner pertinent to that amendment. This is exactly what occurred in Ball. In Ball, an added-in-prosecution limitation was removed by reissue, even despite the fact that this limitation was added after a suggestion by the examiner as a way to obtain allowance.

Ball, 729 F.2d 1429, 1342. Current law dictates that the permissibility of broadening a claim in an aspect related to surrendered subject matter hinges on whether the newly added limitations are materially limiting.

Accordingly, to the extent the Examiner and/or the MPEP contend that the addition of an element in prosecution bars its removal, appellant submits that they are wrong.

2. Did, applicant “surrender” any and all subject matter that lacks the “virtual device driver” limitation?

From the above discussion, it is apparent that the mere canceling of a claim effects a surrender of only the subject matter of the surrendered claim. To be clear, that means the applicant is estopped from pursuing a claim that has the same scope as the canceled claim. No further estoppel flows from the mere claim cancellation. In some cases, it has been argued, largely unsuccessfully, that the patentee is estopped from obtaining a different scope of claim if the prosecution history **amounts to an admission** that a particular claim scope is not patentable or that a particular claim element is required for patentability. Here, appellant neither explicitly nor effectively made any admission which would preclude appellant from obtaining the presently proposed reissue claims.

The recapture rule does not apply in the absence of evidence that the applicant’s amendment was an admission that the scope of the claim sought was not in fact patentable. See, Clement, 131 F.3d 1464, 1469 (citing Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, (Fed. Cir. 1984)). If the applicant admitted something was unpatentable, then it cannot be said to be an “error” correctable under the reissue statute. It follows that the recapture doctrine can not apply to bar a reissue unless the applicant admitted the scope of that claim is not patentable.

Such an admission can occur by (1) amending a claim; or (2) making statements that amount to an admission that a claim is unpatentable. In the first case, if an applicant

amends a claim, the applicant is tacitly admitting that they do not believe that the claim is patentable as it stands. An amendment of a claim is equivalent to a cancellation of the claim and replacement with another claim of narrower subject matter. Clement, 131 F.3d 1464, 1469 (“Amending a claim “by the inclusion of an additional limitation [has] exactly the same effect as if the claim as originally presented had been canceled and replaced by a new claim including that limitation.” In re Byers, 230 F.2d 451, 455, (CCPA 1956).). Either approach results in the **original** subject matter being surrendered by the applicant.

Applicant’s amendments in the prosecution history of the ‘342 Patent surrender the original claim 11 as filed. Applicant added the limitation “virtual” to make the “device driver” a “virtual device driver” in claim 11. This surrender of subject matter is clear. Applicant is not trying to recapture this surrendered subject matter. None of applicant’s reissue claims are equivalent in scope to original and surrendered claim 11. Thus, applicant is not trying to recapture anything that applicant may have effectively admitted is unpatentable by way of a narrowing amendment.

Moreover, applicant contends that applicant did not make any further admissions by argument. Applicant’s statements in the prosecution history of the ‘342 Patent simply do not constitute an admission that the subject matter of that patent was only allowable if the virtual device driver limitation was added. Clearly, adding the virtual device driver limitation to each claim was one manner to overcome the prior art. It was also a way to overcome a § 112, second paragraph rejection. However, applicant did not admit that such an addition was the only way to overcome the prior art. In fact, applicant in essence merely agreed with the Examiner’s conclusion that the prior art did not include the virtual device driver. The Examiner first brought up this point by allowing claim 1 and

suggesting the addition of the “virtual device driver” as a way to obtain allowance. Office Action mailed 1/26/96, p. 6 (“Independent claim 1 is similar to claim 11, except that it specifies the use of *virtual* device drivers to provide power control over devices, instead of using the normal devices drivers of claim 11. As virtual device drivers have no permanent tie to specific hardware, their use in controlling power to specific hardware is considered a novel departure from normal methods of power control.”) (emphasis in original). Such an acquiescence and a later reminder that this aspect distinguishes the prior art simply does not amount to an admission that the “virtual device driver” limitation is a necessary precondition to patentability.

In contrast, in Hester, the Court found that the applicant’s **arguments** effectively were an admission that the applicant’s claims were not patentable without the argued features. That is not the case here. In Hester, both the District Court and Federal Circuit expressed “discomfort” with the applicant’s attempts to remove “solely with steam” and “two sources of steam” limitations that were heavily relied on to obtain allowance of the original patent claims in view of the prior art. In Hester, the inventor Williams, through his attorney, first distinguished a specific prior art reference as not cooking solely with steam or having two sources of steam. As the Examiner continued to reject the claims, Williams repeatedly and emphatically argued these limitations and placed even greater reliance on the “solely with steam” and “two sources of steam” limitations in both of his appeal briefs (two different appeals were filed). The Board of Patent Appeals and Interferences (“Board”) agreed with Williams and cited both the use of steam as the sole cooking medium and the two sources of steam as distinguishing characteristics over the prior art.

Appellant by no means placed such heavy reliance on the virtual device driver limitation. Appellant at most agreed with the Examiner that this limitation let to the various patentable combinations now claimed. To not pursue other claims without this limitation was an error within the meaning of 35 USC § 251.

Thus, the Examiner misconstrues what applicant surrendered in the prosecution of the '342 patent. The Examiner repeatedly compares the newly proposed reissue claims to the issued claims containing the "virtual device driver" limitation, not to the claims applicant gave up. The proper inquiry is a comparison of the scope of the proposed reissue claims to the original claims. It is the original claims that were surrendered. Appellants statements and actions in the prosecution history surrendered no more.

3. Does the recapture doctrine bar the independent claims?

As discussed above, the standard for whether claims are permissible in a reissue is whether they differ materially from the surrendered subject matter.⁶ As also discussed above, appellant contends that the term, “virtual device driver” in claim 11 as originally filed in the ‘342 patent constitutes the surrendered subject matter.

The following chart summarizes claim 11 and the independent claims.

11. A computer system comprising: a bus; a central processing unit (CPU) coupled to the bus running an operating system and at least one power-unaware application, wherein the operating system has a virtual device driver performing device idle detection using one or more events timers indicating the activity level of at least one local device, and further wherein the virtual device driver places idle local devices in a reduced power consumption state when associated events timers indicate that no activity has occurred for a predetermined period of time transparent to said at least one power-unaware application.	36. A machine-readable medium having stored thereon instructions, which if executed by a machine, cause said machine to perform operations comprising: determining an amount of time a processor is in a first power consumption state, said amount of time said processor is in said first power consumption state comprising a period of time in which a clock of said processor is stopped; reducing a voltage level applied to said processor in response to said amount of time said processor is in said first power consumption state.
11. A computer system comprising: a bus; a central processing unit (CPU) coupled to the bus running an operating system and at least one power-unaware application, wherein the operating system has a virtual device driver performing	42. A machine-readable medium having stored thereon instructions, which if executed by a machine, cause said machine to perform operations comprising: determining an amount of time a clock of a processor is stopped; placing said processor into a reduced power consumption state in response to said

⁶ Some cases have considered the relevance of the added limitation to the prior art or the prior art rejection, or analyze the relationship between the narrowing and broadening of a particular limitation originally added in prosecution. This analysis is useful and even “important” in some cases. See, e.g., Clement, 131 F.23d 1464, 1470. (“In both Mentor and Ball, the relevance of the prior art rejection to the aspects narrowed in the reissue claim was an important factor in our analysis”). However, the underlying inquiry is whether the claims differ in a material respect, and the other inquiries are inapplicable and/or confusing in other cases. See Appellant’s Argument with respect to issue 14, below. The materiality is defined by the sufficiency of the limitation to overcome the references of record in the case. To the extent some of the other tests seem appropriate to particular limitations, appellant explains how the test elements are met.

<p>device idle detection using one or more events timers indicating the activity level of at least one local device, and further wherein the virtual device driver places idle local devices in a reduced power consumption state when associated events timers indicate that no activity has occurred for a predetermined period of time transparent to said at least one power-unaware application.</p>	<p>amount of time said clock of said processor is stopped.</p>
<p>11. A computer system comprising: a bus; a central processing unit (CPU) coupled to the bus running an operating system and at least one power-unaware application, wherein the operating system has a virtual device driver performing device idle detection using one or more events timers indicating the activity level of at least one local device, and further wherein the virtual device driver places idle local devices in a reduced power consumption state when associated events timers indicate that no activity has occurred for a predetermined period of time transparent to said at least one power-unaware application.</p>	<p>49. An apparatus comprising: a power management module to determine an amount of time a processor is in a first power consumption state, said first power consumption state comprising a period in which said processor is stopped; a power reduction module to place said processor into a reduced power consumption state in response to said amount of time said processor is in said first power consumption state.</p>
<p>11. A computer system comprising: a bus; a central processing unit (CPU) coupled to the bus running an operating system and at least one power-unaware application, wherein the operating system has a virtual device driver performing device idle detection using one or more events timers indicating the activity level of at least one local device, and further wherein the virtual device driver places idle local devices in a reduced power consumption state when associated events timers indicate that no activity has occurred for a predetermined period of time transparent to said at least one power-unaware application.</p>	<p>58. An apparatus comprising: a power management module to determine an amount of time a processor is in a first power consumption state, said first power consumption state comprising a period in which said processor is stopped; a power reduction module to place said processor into a reduced power consumption state in response to said amount of time said processor is in said first power consumption state, said power reduction module comprising a software routine, said power management module comprising a timer.</p>
<p>11. A computer system comprising: a bus;</p>	<p>59. A system comprising: a memory;</p>

<p>a central processing unit (CPU) coupled to the bus running an operating system and at least one power-unaware application, wherein the operating system has a virtual device driver performing device idle detection using one or more events timers indicating the activity level of at least one local device, and further wherein the virtual device driver places idle local devices in a reduced power consumption state when associated events timers indicate that no activity has occurred for a predetermined period of time transparent to said at least one power-unaware application.</p>	<p>a processor coupled to said memory; a power management module to detect an amount of time said processor is in a first power consumption state, said first power consumption state comprising a period of time in which a clock of said processor is stopped, said processor being placed into a reduced power consumption state in response to said amount of time said processor is in said first power consumption state.</p>
<p>11. A computer system comprising: a bus; a central processing unit (CPU) coupled to the bus running an operating system and at least one power-unaware application, wherein the operating system has a virtual device driver performing device idle detection using one or more events timers indicating the activity level of at least one local device, and further wherein the virtual device driver places idle local devices in a reduced power consumption state when associated events timers indicate that no activity has occurred for a predetermined period of time transparent to said at least one power-unaware application.</p>	<p>77. A method comprising: determining an amount of time a clock of a processor is stopped; placing said processor into a reduced power consumption state in response to said amount of time said clock of said processor is stopped.</p>

Claim 36 unquestionably claims subject matter of a different scope than did original claim 11. There are numerous differences in language, as is readily apparent upon only a cursory examination.

The differences are also more than superficial, and indeed are quite material. More particularly, the ways in which claim 36 is narrower than claim 11 are material. A “virtual device driver” does not inherently provide the ability to determine an amount of

time a processor is in a particular power consumption state. Nor does a device driver inherently possess the ability to detect whether a clock of the processor is stopped. Furthermore, a device driver does not inherently possess the ability to reduce a voltage level of the processor based on the amount of time the processor is in a particular power consumption state. A device driver could perform these functions as claimed in claim 11. In other words, surrendered claim 11 does not explicitly or inherently recite any specific power management functions possessed by the device driver. Claim 36, however, recites specific functions performed in specific ways that could be performed by a virtual device driver.

As an analogy, consider a knife, which has multiple functions. It can be used to cut things, such as a steak, to fillet a fish, or to pry things apart, etc. If a claim of a patent recited “a knife to cut”, would it be materially more limiting to remove this limitation and replace it with one that recited a cutting device to fillet a fish? Clearly, the cutting device is materially related to a knife, as one is an example of the other. Although, the cutting device is not a narrower limitation than the knife, the specific function to be performed by the cutting device is vastly more limiting than the mere limitation “to cut”, as it details precisely what the cutting device is being used to cut (a fish) and how the cutting device is being used (to fillet).

However, under the Examiner’s interpretation of Pannu and other relevant cases, this would be impermissible recapture. In fact, under the Examiner’s interpretation of Pannu in particular, the newly modified claim would have to include a limitation, “a knife to slice a steak starting at a first edge of the steak and continuing until an opposite edge of the steak is reached by the cutting device”. No broadening reissue would be necessary in

this case, since the newly modified claim includes the “knife” limitation. This simply cannot be the correct interpretation of Pannu and other case law on the matter if the practice of broadening reissue is to survive.

Similar to the knife analogy, claim 11 recited a virtual device driver to perform device idle detection by using event timers to monitor the activity level on the device. The Reissue claims, however, recite the limitation of a module or software instructions (a broader limitation than “virtual device driver”, much like a “cutting device” is broader than “knife”) to determine an amount of time a device, such as a processor, is in a certain power state by detecting a period of time the clock of the device is stopped. The latter limitation, much like the limitation of “to fillet a fish” in the knife example, is materially narrower than the corresponding limitation of claim 11 (“performing device idle detecting [by using]... event times indicating the activity level of the..device”). Event timers can indicate activity level in a device any number of ways, including timing of periods of current draw, bus events, periods of electromagnetic activity surrounding the device, and the amount of time the device’s clock is stopped. However, the Reissue claims were specifically limited to determining power consumption based on the amount of time the device’s clock is stopped. Therefore, the Reissue claims, and claim 36 in particular, although broader in one aspect, are narrower than claim 11 in at least one aspect materially related to the recaptured limitation, “virtual device driver”.

Similarly, claim 42 recites a method that performs operations of the instructions claimed in claim 36 – determining an amount of time a processor clock is stopped and placing the processor in an appropriate power state in response thereto. Therefore, claim 42 is limiting in a material manner to the limitation, “virtual device driver”, removed

from claim 11. Although claim 42 does not recite the limitation of claim 36 pertaining to reducing the voltage of the processor in response to the clock being stopped, the limitation pertaining to determining an amount of time the clock is stopped is a particular function that a device driver could carry out to monitor power consumption and therefore materially narrower than merely claiming “virtual device driver” to detect a processor “activity level”, as in claim 11.

Claim 49 similarly claims an apparatus for performing the method recited in claim 42. Therefore, claim 49 is materially narrow in at least the same respect as claim 42, in relation to the removed limitation, “virtual device driver”, of claim 11.

Claim 58 includes the limitations of claim 49, plus the limitations of a module comprising software (much like a virtual device driver) and a timer. Although the timer may or may not be materially related to the removed limitation “virtual device driver”, the limitation of a module including software to perform the functions recited in claim 58 certainly is, as device drivers are typically software routines. Therefore, the limitations recited in this claim are even more related to the removed limitation “virtual device driver” of claim 11. Moreover, claim 58 includes the limitations of claim 49 and therefore is materially narrower in respect to the limitation, “virtual device driver”, in a similar manner.

Claim 59 recites a system having a the same limitations of claim 49. Therefore, claim 59 is materially narrowing in respect to the limitation “virtual device driver” to the extent claim 49 is materially narrow in this respect.

Claim 77 is a method comprising operations that may be carried out by the apparatus of claim 49 and the system of claim 59. Accordingly, claim 77 is materially

narrowing in respect to the limitation “virtual device driver” to the extent claims 49 and claims 59 are materially narrow in this respect.

From the foregoing discussion, it should be clear that the independent claims of the present Reissue Application are definitely broader than claim 11 in at least one key respect – the removal of the limitation “virtual device driver”. However, the independent claims each claim at least one limitation that is a specific function that a virtual device driver may perform. Furthermore, each independent claim recites at least one specific way in which the specific function should be carried out. Similar to the example of a knife, the independent claims claim a genus of the structure (e.g., a “module” instead of a “virtual device driver”), but claim a narrowly defined species of the function (e.g., “determining...a period of time in which a clock of the processor is stopped” instead of merely “detecting activity level of the processor”) of the removed limitation, “virtual device driver” of claim 11. Therefore, the independent claims, while broader than claim 11 in one respect, are narrower in at least one respect material to the removed limitation, “virtual device driver”.

4. Is the Judicially Created Recapture Doctrine inherently and irreconcilably inconsistent with the Reissue Statute, 35 USC § 251, which permits broadening of claims, and now devoid of its original purpose of ensuring comity to the prosecution-history-reading public?

A. The Recapture Doctrine is Inconsistent with the Purpose of Broadening Reissue Practice

A broadening reissue application was first upheld as valid in Battin v. Taggart, 58 U.S. 74 (S.Ct., 1854). Battin’s original patent covered the combination of a coal breaking roller and a screen, whereas the broadening reissue claimed the breaking roller alone. The Court in Battin explained that a patentee had a “right to restrict or enlarge his claim, so as to give it validity and to effectuate his invention.” See, Chisum on Patents, §15.01.

The holding of Battin served to further refine the requirements under §3 of the Patent Act of 1832, which allowed a patentee to apply for a reissue if the original patent is invalid or inoperative due to “inadvertence, accident, or mistake, and without any fraudulent or deceptive intention” on the part of the inventor. 1832 Patent Act, § 3.

The holding of Battin was upheld and further refined in Topliff v. Topliff, 145 U.S. 156 (S.Ct., 1892) , in which the U.S. Supreme Court upheld the present limitation of **two years** from the filing date of the original patent to obtain a broadening reissue. In Topliff, Justice Bradley reiterated the import of the underlying policy announced in Battin in awarding a broadening reissue to a patentee who failed to claim the full scope of his invention without deceptive intent:

The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation.
Topliff, 145 US 156, 171.

The extent to which a patentee may correct his failure to claim all that he has disclosed in the patent was limited by Leggett v. Avery, 101 US 56 (1879), to that which the patentee had not voluntarily surrendered during the course of prosecution of the original patent. Specifically, the patentee in Leggett had cancelled all but one claim in a reissue application at the request of the examiner in order to secure a term extension. The patentee subsequently re-applied for a term extension on the earlier abandoned claims.

Because the claims were abandoned in order to secure the reissue extension, the Court explained, the patentee was estopped from subsequently reclaiming them. Leggett became the basis for what became known as the “recapture doctrine”.

Recapture of surrendered matter by canceling claim limitations added during prosecution of the original patent was held to be permissible under certain situations, “but not at the expense of innocent parties”, the Court announced in Sontag Chain Stores v. National Nut Co., 310 U.S. 281 (1940). Accordingly, the Court in Sontag imposed a limitation on what should be considered “inadvertence, accident, or mistake” to that which was not surrendered during the prosecution of the original patent in order to secure the patent.

The court-made exception to the broadening reissue statute was not contemplated by earlier statutes and was directly in conflict with the purpose of broadening reissue practice announced in Battin and Topliff.

B. The Recapture Doctrine is Counter to the Legislative Intent in Enacting 35 USC §251

In 1952 the requirement of “inadvertence, accident, or mistake” was removed from the reissue statute and replaced by “error without deceptive intention” in 35 USC §251 (the ’52 Act). Although the legislative history is silent as to the explicit meaning of the term “error” in the statute, the court in Ball Corp. v. U.S., 729 F.2d 1429 (Fed. Cir., 1984), observed that the 1952 revision of the patent laws made no substantive change in the definition of error under section 251. There is no evidence in the legislative history, however, that the legislature intended the recapture doctrine to survive in the definition of

“error”. Indeed, 35 USC §251 makes no mention of the recapture doctrine despite the fact that the recapture doctrine was a mature, commonly used doctrine in the courts at the time §251 was enacted.

If the recapture doctrine existed at the time 35 USC §251 was enacted, and the doctrine was considered by the legislature to be a favorable and important supplement to the practice of patent reissuance, it would not be unreasonable to expect the legislature to at least mention the recapture doctrine in the language of the statute. Indeed, the absence of any reference to the recapture doctrine in 35 USC §251 coupled with the legislature’s replacement of “inadvertence, accident, or mistake” with a broader requirement of “error without deceptive intention”, would lead one to believe that the recapture doctrine was not intended to survive in patent law jurisprudence after the enactment of the statute.

Furthermore, the existence of 35 USC § 252 indicates that Congress did provide protections to the public to the extent Congress deemed appropriate. The intervening rights protections of 35 USC § 252 explicitly provide the safety net for the public that Congress intended in the ’52 Act in the situation of a broadening reissue. To find that other equitable protections exist runs directly contrary to Congress’ explicit provision of intervening rights in 35 USC § 252.

C. Case Law Subsequent to 1952 has Broadened the Scope of the Basis for Broadening Reissue while Narrowing the Recapture Doctrine

Although the court in Ball believed that §251 did not substantively change the error requirement for broadening reissue applications, patentees since 1952 have been granted greater latitude by the courts as to what may be considered “error” under 35 USC

§251, as evidenced by cases, such as In re Richman, 409 F.2d 269 (CCPA, 1969), In re Wesseler, 367 F.2d 838 (CCPA, 1966), In re Willingham, 282 F.2d 353 (CCPA, 1960), which held, among other things, that “error” should be construed liberally and applied the statute accordingly.

For example, in Wesseler, the CCPA relaxed somewhat the strict requirement that the patentee cannot reclaim that which he surrendered to secure the patent under cases, such as Shepard and Sontag, to a requirement that there merely must be no evidence that the appellant intentionally omitted or abandoned the claimed subject matter. Later, in In re Petrow, 402 F.2d 485 (CCPA, 1968), the CCPA further expanded the “error” requirement by stating that the error requirement is satisfied where the deliberate cancellation of claims does not amount to an admission that the reissue claims were not patentable. Furthermore, the recapture doctrine has been said not to apply where there is no evidence that the amendment of originally filed claims was an admission that the scope of the claims were not patentable, Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, (Fed. Cir. 1984).

The result of case law, such as Wesseler, Petrow, Willingham, and Seattle Box, is an expansion of the basis for which a broadening reissue will be allowed. Specifically, prior to the enactment of 35 USC §251, a patentee could only secure a broadening reissue if the reissue claims did not include matter that was surrendered during the prosecution of the original patent in order to secure the patent. However, after the enactment of 35 USC §251, the case law, including Wesseler, Petrow, and Seattle Box, indicates that the deliberate cancellation of matter in the original patent does not necessarily bar the patentee from reclaiming that subject matter in a broadening reissue, unless there is

evidence the patentee **intentionally surrendered** the subject matter, such that the surrender of the subject matter amounted to an **admission of unpatentability of the scope of a claim sought in reissue.**⁷

The concept of error perhaps reached its zenith in Richman, which addressed the situation of recapturing claim matter in a broadening reissue after amending the claim to add limitations to gain allowance of the claim in the prosecution of the original patent. In Richman, the patentee sought to broaden Claims 23 and 26 by characterizing the relevant control signal value in terms of its condition when a synchronizing signal and a reference signal are in synchronization, instead of the original narrower characterization of the control signal, which relied upon the phase relationship of the generated reference signal and the synchronizing signal.

In response to the examiner's rejection of Richman Claims 23 and 26 on the grounds that the errors to be corrected are not the type contemplated by 35 U.S.C. §251, i.e., not errors arising out of 'inadvertence, accident, or mistake', Judge Rich stated, "The phrase 'inadvertence, accident, or mistake' does not appear in 35 USC §251 but is derived from the patent statutes in force prior to the 1952 Act." Richman, 409 F.2d 269, 273. Furthermore, Judge Rich added, "We pointed out in In re Wesseler, that the term 'error', as set out in 35 USC §251, 'is to be interpreted as Congress has stated it, 'error without any deceptive intention', and in light of Supreme Court decisions favoring the liberal construction of reissue statutes in order to secure to inventors protection for what they have actually invented.' " Richman, 409 F.2d 269, 273.

Judge Rich went on to distinguish the case at bar from Shepard by noticing that

⁷ These cases make it clear that, at least, the patentee is entitled to pursue claims of different scope, so long as no admission of unpatentability has occurred and so long as claims of the same scope are not being

the omission of the limitation in Shepard, “would have resulted in the claim being drawn to the same subject matter as the original rejected claim...thus making it unpatentable for the same reason as the original claim.” Richman, 409 F.2d 269, 274. Judge Rich could not, “..therefore, find [Shepard] to be authority for the proposition that a limitation added to a claim in obtaining its allowance cannot be broadened, under present statutory law, by reissue if the limitation turns out to be more restrictive than the prior art required.” Richman, 409 F.2d 269, 275. “Certainly”, Rich expounded, “one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.” Richman, 409 F.2d 269, 275. Judge Rich ultimately concluded that the patentee did not intend to settle for less protection than he was entitled merely by acting deliberately in limiting the rejected claim in manner that he later found to be improper for his purposes.

Cases, such as Petrow, Wessler, and Richman, illustrate the equitable and logical reality that the court-made doctrine prohibiting recapture of surrendered claim subject matter has little place in the post-1952 world, in which patentees must only show “error without deceptive intention” in order to secure a broadening reissue. Indeed, since the ’52 Act was enacted, the courts have progressively and rightfully acknowledged that a patentee’s failure to appreciate the scope of the claims of his original patent is a valid error within the meaning of the statute, In re Wilder, 736 F.2d 1516 (Fed. Cir., 1984), thereby entitling him to claims limited only by the boundaries defined by the prior art.

Just as case law has expanded the basis for obtaining a broadening reissue 35 USC §251, the recapture doctrine has been narrowed, accordingly.

D. Requiring Patentee to Materially Narrow a Claim Containing Recaptured
Matter in order to Escape the Recapture Doctrine is Counter to the Intent of the
Broadening Reissue Statute

Recent cases have attempted to mask the inconsistencies between 35 USC §251 and the recapture doctrine by requiring the patentee to narrow the scope of a broadening reissue claim in a manner related to what the patentee surrendered during prosecution of the original patent to secure the patent. Similar to the recapture doctrine itself, the “narrowing requirement” has no basis in 35 USC §251, which only requires “error without deceptive intention” as a basis for filing a broadening reissue. Indeed, if the requirement for obtaining a broadening reissue is “error without deceptive intention”⁸, and a “failure to appreciate the scope of the invention”⁹ that results in the patentee “adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art”¹⁰, then why should a patentee be compelled to further limit his claim to a scope that is more than what is necessary to overcome prior art?

The narrowing requirement of the recapture doctrine is not only counter to the statute, but it is inconsistent with the intended purpose of the broadening reissue practice announced in earlier cases, such as Battin and Topliff – that the inventor should be entitled to claim all he has invented.

Contrary to the statements in Ball, Mentor, Hester, Clement, and most recently,

⁸ 35 USC §251.

⁹ see generally, Wilder, 736 F.2d 1516.

Pannu, the narrowing requirement of the recapture doctrine provides little if any protection or predictability to a would-be infringer, because neither the recapture doctrine nor the narrowing requirement necessarily protects the would-be infringer against a patentee pursuing claims containing the recaptured matter. In particular, even though a patent is amended to issue with narrowed claims, the patentee could, and commonly does, file a continuation application to pursue broader claims. The narrowing of the issued claims provides no protection to would-be infringers in this commonplace scenario.

Moreover, the patentee should fear that broadened claims may be obtained by reissue. That is exactly what the statute allows. All members of the public are on notice that a broadening reissue can be filed within two years of the issue date of any US patent. The would-be infringer operating in the two-year broadening reissue window is protected without any equitable recapture doctrine. The intervening rights protections of 35 USC § 252 explicitly provide the safety net that Congress intended in the situation of a broadening reissue. To find that other equitable protections exist runs directly contrary to Congress' explicit provision of intervening rights in 35 USC § 252. Yet, the recapture doctrine persists, hurting patentees and affording a would-be infringer a very narrow and largely theoretical degree of protection from infringement litigation.

Not only is the recapture doctrine and the requirement that a patentee must narrow his claim in a manner that is necessary to overcome prior art in order to avoid the doctrine not consistent with 35 USC §251 and subsequent case law relating to the scope of “error without deceptive intention”, but these requirements, when balanced against the inequities and burden placed on the patentee, afford very little, if any, predictability or protection to a would-be infringer.

¹⁰ see generally, Richman, 409 F.2d 269.

E. The Recapture Doctrine is Impractical Due to the Varying Standards for the Narrowing Requirement in Recent Case Law and the Factually-Intensive Analysis that Must be Applied

In Leggett, Justice Bradley stated that the purpose of preventing a patentee from reclaiming in a broadening reissue that which he had surrendered to secure the original patent was to allow the public to rely on what the patentee surrendered to obtain the issued patent. However, as the basis for obtaining a broadening reissue has expanded under cases such as Petrow, Richman, Wesseler, and Wilder, the recapture doctrine has also expanded to require the patentee to narrow the scope of the claim in some particular way in an effort to uphold the principals announced in Leggett.

However, the rules governing the “narrowing requirement” vary from case to case, resulting in confusion among patentees, practitioners, and would-be infringers as to how the recapture doctrine should be applied. Indeed, the recapture doctrine together with the associated narrowing requirement has evolved into a factually-intensive inquiry that neither the Courts nor potential litigants can apply consistently.

For example, in Ball, the patentee had canceled original claims directed to a single feed means in order to avoid prior art and secure a patent. The patentee then filed reissue claims containing the limitations of an electrical signal feed assembly and a dielectric-filled cavity between the two conductors. The Court allowed the patentee to recapture the broader single feed limitation because with the limitations of the electrical signal feed assembly and the dielectric-filled cavity, the overall scope of the reissue claims were narrowed with respect to the scope of the originally canceled claims. Although the

patentee had broadened the reissue claims in a manner related to the elements that were surrendered, the claims were narrowed in scope by the additional limitations overall. Therefore, the court said, patentee had avoided the recapture doctrine.

In Mentor, on the other hand, the patentee sought to recapture in the reissue claims the limitation of transferring adhesive from an outer layer to the inner layer in order to read on a competing product. The patentee included other limitations in the reissue that the Court decided were not “materially limiting” in relation to the feature the patentee surrendered to secure the patent – the transfer of adhesive from an outer layer to an inner layer. Unlike in Ball, the court in Mentor looked to how the claims were limited in relationship to the features surrendered during the prosecution of the original patent rather than the overall scope of the reissue claim in relation to the scope of the original claim. Furthermore, Mentor queried whether the narrowing limitation was “material” to the recaptured matter, whereas Ball mentions no such requirement.

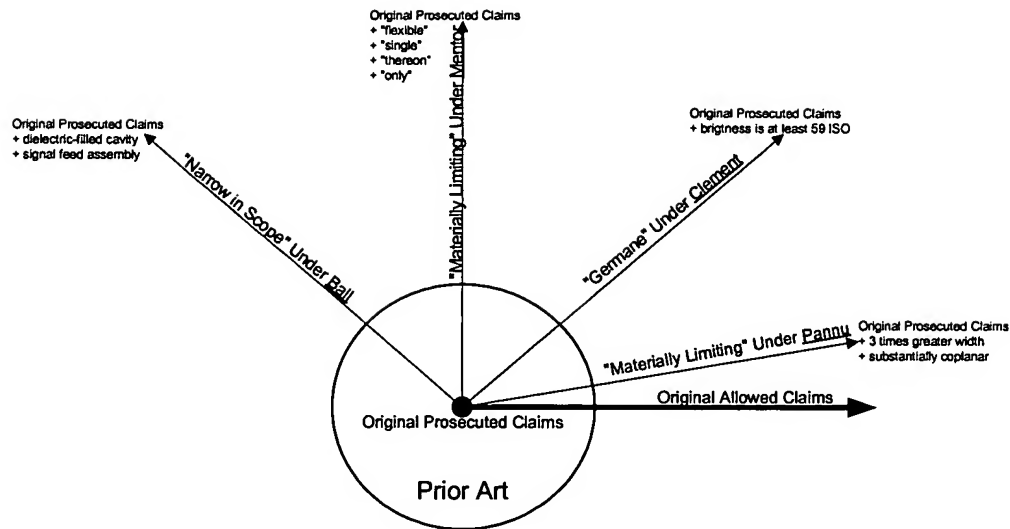
The inquiries surrounding recapture changed once again in Clement, which questions if a limitation added to the reissue claim was “germane” to the surrendered claim matter. Specifically, because the patentee had removed several limitations from the original claims that were added and argued to overcome prior art while adding a limitation that was not “pertinent to” the removed limitations, the recapture doctrine prevented the patentee from regaining the surrendered subject matter.

More recently, Pannu indicated that the standard of “materially narrowing” may mean something more restrictive than simply “germane” as in Clement or something that merely narrows the overall scope of the claim as in Ball. In Pannu, the court stated that a limitation added to a reissue claim relating to the positioning and dimensions of a lens

haptic was not materially related to the limitation relating to the shape of the haptic added during prosecution yet removed in the reissue. The court found that the claims were not “narrow[ed] in any material respected compared with their broadening”. Pannu, 258 F.3d 366, 372. .

Pannu implies that it may no longer be sufficient to merely “limit the scope” of the claim overall or limit the reissue claim that is “pertinent to” the surrendered matter, because the limitation added in the reissue claims in Pannu no doubt limited the overall scope of the claim in a way that was at least pertinent or germane to the configuration of the lens haptic. Pannu argued that being germane to the configuration was sufficient, but the Court cited the lack of a closer nexus than configuration, actually stating that the original added claim limitation was on the shape, and the newly added limitation pertained to the positioning and dimensions.

What remains in wake of Pannu is uncertainty and unpredictability in how to properly limit a reissue claim in a manner that is materially limiting and if there is any necessary relationship to the surrendered matter of the original claim. The diagram below illustrates the gradual restriction of the “material limiting” requirement from the decision in Ball, through Mentor, Clement, and most recently in Pannu.



Great inconsistency exists with regard to what is considered to be a suitable limitation in reissue claims to overcome the recapture doctrine. The center point of the circle represents the original claim that was rejected and subsequently abandoned by the patentee in favor of the original allowed claim (vector to the right). The circle around the original prosecuted claims represents “immaterial” deviations from the originally proposed (and abandoned) claims. The patentee escapes the circle of immaterial differences to get the originally allowed claims allowed. The direction that the patentee chose to escape the circle of immaterial differences is represented by a vector to the right. The recapture doctrine precludes claiming anything including the original prosecuted claim and anything within the circle of immaterial differences thereabout.

In Ball, as long as the claims were narrowed sufficiently to escape the circle of immateriality, it was not essential to move in the direction of the original allowed claims vector, as long as the claim was narrowed overall. Under Mentor, the court inquired as to whether the claims were “narrow[ed] in any material respect compared with their broadening”. Mentor, 998 F.2d 992, 996. This begins to imply a closer relationship to

the direction originally chosen by the patentee to escape the prior art rejection. Similarly, in Clement, the Court inquired as to whether the claims were narrower in an aspect germane to the prior art rejection. Finally, Pannu inquired whether the reissue claims were “narrowed in any material respect compared with their broadening”. Pannu, 258 F.3d 366, 372. These inquiries tend to tie the required reissue limitation closer and closer to the limitation added during prosecution. This trend is simply inconsistent with the precedent that indicates an applicant may act deliberately in adding a claim limitation, but that deliberate act may be an error.

As appellant described above, appellant believes that under current law, all that is required is that the new reissue claims escape the circle of immaterial differences from the original prosecuted claims to avoid recapture. The “germane”, “narrowed in any material respect to their broadening” and “narrowed in any material respect compared with their broadening” inquiries of Clement, Mentor, and Pannu may be useful, but are not controlling.

The result of recent cases, such as Ball, Mentor, Clement, and Pannu, is a doctrine that is at best confusing. Furthermore, if the would-be infringer or his agent is able to determine with any degree of certainty from prosecution history whether the above highly factual inquiry subjects him to infringement liability, he still may be subject to litigation if there are any co-pending continuations of the original patent. Therefore, under the broadening reissue statute, 35 USC §251, the recapture doctrine in its current state fails to provide any real degree of reliance to the public on claims granted to the patentee for the parent/original application.

The recapture doctrine, which was created to prevent a patentee from reclaiming

what he had surrendered during prosecution of the original patent to avoid prior art, is directly at odds and wholly inconsistent with 35 USC §251, which has been interpreted in the last 50 years to allow the correction of deliberate surrender of subject matter to avoid prior art. The restrictions that recent courts have placed on added claim limitations that allow a patentee to avoid the recapture doctrine in order to promote certainty, fairness, and confidence in the minds of would-be infringers has been attenuated, if not eviscerated, by the factually intensive inquiry and inconsistent standards of the current recapture doctrine.

Therefore, the recapture doctrine should be abolished in favor of a consistent application of the broadening reissue law in 35 USC §251, which should be interpreted to allow a patentee to obtain claims in a broadening reissue so long as an error without deceptive intent occurred, and so long as the prior art is not covered by the reissue claims.

5. Is the Failure of an Attorney to Appreciate the Scope of the Invention Sufficient Error upon which the Applicant may rely as a Basis for a Broadening Reissue?

A. 37 CFR §1.175 Does NOT Require Applicant to Cite at Least One Error Being Relied on as a Basis upon which the Applicant Relies in Support of a Broadening Reissue.

37 CFR §1.175(a)(1) states:

The reissue oath or declaration ...must...state that...[t]he applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, **stating at least one error being relied upon as the basis for reissue...**
MPEP R-90

Nowhere in 37 CFR §1.175(a)(1) does it state that the Applicant must cite a specific error in the claims or specification of the original patent in order to fulfill the requirement that the Applicant must state at least one error being relied upon as the basis for reissue. However, the Examiner relies on this assertion in virtually every Office Action in the prosecution of the reissue application as a basis for objecting to Applicant's oath/declaration.

Specifically, the Examiner states:

The reissue oath/declaration filed with the application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEPE §1414.

The...declaration..fails to identify a specific error relied upon to support the reissue. 37 CFR 1.175 and MPEP §1414 require the identification of a specific error. **The general statement that the claims are too narrow because the attorney failed to appreciate the full scope of the invention does not specifically identify a word, phrase, or expression in the specification or an original claim that renders the original claim wholly or partially inoperative.** Office Action mailed 09/23/2003.

The Examiner makes the above assertion in virtually every Office Action until Applicant, in the interest of appeasing the Examiner in order to expedite prosecution, cites the claim term "virtual device driver" as an error upon which Applicant relies in support of the reissue. However, the Applicant did not concede that this is an accurate reading of 37 CFR 1.175(a)(1), and in fact the record is replete with objection by the Applicant as to the above assertion by Examiner.

For example, Applicant states:

Applicant has stated, and restates in the present Amendment, that the "specific error" requested in the present Office Action is the unduly narrow claims of the parent Application resulting from the attorney failing to appreciate the scope of the invention. Furthermore, as indicated above, both the Federal Circuit and the MPEP consider such an error to be permissible grounds for filing a reissue application. Response to Office Action Mailed 4/2/02.

Up until the point that Applicant sees no other alternative than to cite the phrase "virtual device driver" in the claims as an error upon which Applicant relies in support of

the reissue, Applicant made every attempt to educate the Examiner on relevant case law, MPEP sections, and the relevant CFR section. Still, the Examiner persisted in requiring the Applicant to specify a specific error in the claim, even though this requirement is not found in 37 CFR §1.175(a)(1), as alleged by the Examiner.

Rather, 37 CFR §1.175(a)(1) merely states that Applicant must submit an oath or declaration stating that he believes the original patent to be wholly or partially inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to. Furthermore, the CFR requires a statement of at least one error being relied upon as a basis for the reissue.

As Applicant will explain the following sections, neither the CFR, the MPEP, nor case law interprets the “error” referred to in 37 CFR §1.175(a)(1) as REQUIRING an applicant to cite a specific error in the claims or specification basis for the reissue. Indeed, both the MPEP and case law explicitly state that attorney’s failure to appreciate the scope of the invention is acceptable “error” as required under 37 CFR §1.175(a)(1) to support a reissue. The Examiner has simply misinterpreted the MPEP and 37 CFR §1.175(a)(1), as requiring a specific error in the claim or specification to be cited and relied upon by the Applicant as a basis for the reissue.

B. The Manual of Patent Examining Procedure (MPEP) Does NOT Require Applicant to Cite a Specific Error in the Claims or Specification of the Parent Application as a Basis upon which the Applicant Relies in Support of a Broadening Reissue.

Not only does 37 CFR §1.175(a)(1) fail to require Applicant to cite a specific

error in the claims or specification of the parent application as a basis for the reissue, but neither does the MPEP. Yet, the Examiner relies on the MPEP in support of his position that Applicant must cite a specific error in the claims or specification of the parent application as a basis for the reissue.

Specifically, the Examiner cites MPEP §1414(II) as a basis for his erroneous assertion, and particularly points out the following excerpts from that section:

In identifying the error, it is **sufficient** that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid.(emphasis added) MPEP §1414(II)

It is not sufficient for an oath/declaration to merely state “this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure.” Rather, **the oath/declaration must specifically identify an error.** (Emphasis added) MPEP §1414(II)

Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. MPEP §1414(II)

It is most likely the last excerpt above that the Examiner relied upon most heavily in his requirement for Applicant to identify language in the claims as the ‘at least one error’ relied upon as a basis for the reissue. However, nothing preceding or following this excerpt would suggest that the excerpt means anything more than “IF an error exists in the claims, then it must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.” For example, the first excerpt merely states that it is “sufficient” to identify a single word, phrase, or expression in the specification or claims wherein the error lies. It does NOT say that the error **MUST** be a single word, phrase, or expression in the specification or claims, but rather it is **SUFFICIENT** for the error to exist in a single word, phrase, or expression.

A plain reading of MPEP §1414(II) or related MPEP sections clearly indicates that “error” within the meaning contemplated in 35 U.S.C. §251 may occur in other forms

than specific errors in the claims, specification, or drawings. Accordingly, Applicant respectfully asserts that in the present reissue examination, the Examiner's requirement that the Applicant identify a specific error in the claim language was a misinterpretation of MPEP §1414(II) and 37 CFR §1.175.

C. Case Law Holds that Attorney's Failure to Appreciate the Scope of the Invention is Sufficient Error upon which Applicant may Rely as a Basis for a Broadening Reissue.

An attorney's failure to appreciate the full scope of the invention was held, in *In re Wilder*, to be an error correctable through reissue. Furthermore, the MPEP relies on the holding of *In re Wilder* as part of the USPTO's examination procedure (see MPEP §1402, 5th paragraph, Pg. 1400-2). Yet, the Examiner in the present reissue has consistently rebuffed Applicant's arguments wherein Applicant directed the Examiner's attention to the specific sentence within the MPEP that sets forth that an attorney's failure to appreciate the scope of the invention as being an error correctable through reissue. Particularly, the Examiner relied on the first sentence of the 7th paragraph of MPEP §1414(II) as a basis for demanding that Applicant specifically cite an error in the claim.

As already discussed, no such requirement exists in the MPEP, including the sentence in §1414(II) relied upon by the Examiner. In the present reissue, Applicant has consistently alleged that it was the attorney's failure to appreciate the full scope of the invention that was the "at least one error" relied upon by the Applicant as a basis for the reissue. At no point in the prosecution of the present reissue, before the point that Applicant conceded to the Examiner's demands in his response to Office Action mailed

9/23/2003, did the Applicant make any mention of a specific error in any word, phrase, or expression in the original parent claims.

In a last attempt to explain to the Examiner that the error was a failure of the attorney in the case to appreciate the full scope of the invention, Applicant attempted to create the following synopsis of relevant sections of the MPEP in support of Applicant's position:

"A reissue applicant must acknowledge the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective" (MPEP §1414(II), 1st paragraph, Pg. 1400-22)

"See MPEP §1402 for a discussion of grounds for filing a reissue that may constitute "error" required by 35 U.S.C. §251." (MPEP §1414(II), 1st paragraph, Pg. 1400-22)

"An attorney's failure to appreciate the full scope of the invention was held to be an error correctable through reissue in *In re Wilder* (cite omitted)." (MPEP §1402, 5th paragraph, Pg. 1400-22)

The above synopsis is a reasonable interpretation of the relevant MPEP sections on the matter of what is acceptable error within the meaning of the statute. However, the Examiner responded to this synopsis by relying on three sentences (presented in the previous sub-section of this Appeal) within §1414(II) of the MPEP which do not, either in combination or standing alone, require Applicant to cite a specific error in the claims, as the Examiner insisted.

However, Applicant cannot completely blame the Examiner for his position in this matter. When read as a whole, MPEP sections pertinent to what is an error that may be relied upon in support of a reissue (§§1414, 1402) are at best vague. Particularly, the MPEP does not explicitly say that an error upon which the reissue is based MUST be in the claims, specification, or drawings, but rather provides guidelines in instances in which the error DOES exist in these areas.

In *re Wilder*, on the other hand, as the MPEP acknowledges, leaves open the

possibility that the error could simply be an attorney's failure to appreciate the scope of the invention. This error may manifest itself in specific words, phrases, or expressions of the specification, drawings, or claims. However, this error may also manifest itself in the entire application being partially or wholly inoperable or invalid. In this latter case, it may not be possible to identify a particular phrase, word, or expression in the application that adequately embodies the "error" upon which the Applicant bases the reissue. Alternatively, the error may exist in a position taken by the attorney in the course of prosecution, in which case there would be no manifestation of the error in the specification, drawings, or claims.

Fortunately, *In re Wilder* gives applicants access to reissue practice in these latter cases by essentially allowing attorney mistake or incompetence to serve as the basis for a reissue instead of penalizing the applicant for these mistakes or professional shortcomings. Accordingly, Applicant was entitled to claim in his oath/declaration that attorney's failure to appreciate the scope of the invention was the error relied upon by applicant as a basis for the reissue.

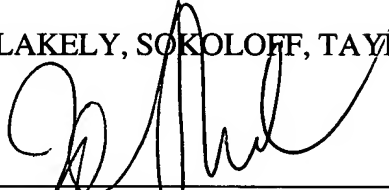
Therefore, Applicant respectfully requests that any reference made to a specific error in the claims, such as Applicant's mention of "virtual device driver" as an error, be stricken from the reissue application file and Applicant be allowed to submit an updated oath/declaration reiterating Applicant's original basis for the reissue – attorney's failure to appreciate the scope of the invention. Alternatively, Applicant respectfully requests that modifications be made to subsequent editions of the MPEP in order to clarify whether an applicant **MUST** in fact cite a specific error in the specification, claims or drawings in his oath/declaration in order to fulfill the requirements of 37 CFR 1.175.

Conclusion

Appellant submits that all claims now pending are in condition for allowance. Such action is earnestly solicited at the earliest possible date. If there is a deficiency in fees, please charge our Deposit Acct. No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

A handwritten signature in black ink, appearing to read 'John Patrick Ward', is written over a horizontal line.

John Patrick Ward
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Date: June 18, 2004

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IX. Appendix A: Claims Involved in Appeal (Clean Copy)

36. A machine-readable medium having stored thereon instructions,
which if executed by a machine, cause said machine to perform
operations comprising:
determining an amount of time a processor is in a first power
consumption state, said amount of time said processor is in
said first power consumption state comprising a period of
time in which a clock of said processor is stopped;
reducing a voltage level applied to said processor in response to
said amount of time said processor is in said first power
consumption state.
37. The machine-readable medium of Claim 36 wherein reducing said
voltage level applied to said processor is performed in
response to said amount of time exceeding a selected
amount of time.
38. The machine-readable medium of Claim 37 wherein
determining comprises reading a timer to determine said
amount of time said processor is in said first power

consumption state.

39. The machine-readable medium of Claim 38 wherein said reducing said voltage level comprises placing said processor in a power-off state.
40. The machine-readable medium of Claim 36 wherein determining the amount of time said processor is in the first power consumption state comprises monitoring an activity level demand within a computer system.
41. The machine-readable medium of Claim 40 wherein reducing the voltage level applied to the processor comprises operating said processor in a reduced power consumption state while satisfying said activity level demand.
42. A machine-readable medium having stored thereon instructions, which if executed by a machine, cause said machine to perform operations comprising:
 - determining an amount of time a clock of a processor is stopped;
 - placing said processor into a reduced power consumption state in

response to said amount of time said clock of said
processor is stopped.

43. The machine-readable medium of Claim 42 wherein said placing
comprises reducing a voltage of said processor.
44. The machine-readable medium of Claim 43 wherein said
determining an amount of time said clock of said processor
is stopped contributes to determining a system idle time.
45. The machine-readable medium of Claim 44 wherein said clock of
said processor is stopped when the processor is in a sleep
state.
46. The machine-readable medium of Claim 45 wherein a timer is read
to determine said amount of time said processor is in said
first power consumption state.
47. The machine-readable medium of Claim 46 wherein said reduced
power consumption state is a power-off state.
48. The machine-readable medium of Claim 43 wherein reducing said
voltage of said processor is performed in response to said

amount of time said clock of said processor is stopped
exceeding a selected amount of time.

49. An apparatus comprising:
- a power management module to determine an amount of
time a processor is in a first power consumption
state, said first power consumption state
comprising a period in which said processor is
stopped;
 - a power reduction module to place said processor into a
reduced power consumption state in response to
said amount of time said processor is in said first
power consumption state.
50. The apparatus of Claim 49 wherein said power reduction module
comprises a software routine.
51. The apparatus of Claim 49 wherein said power management
module comprises a timer.
52. The apparatus of Claim 50 wherein said power management
module comprises a timer.

53. The apparatus of Claim 52 wherein said power reduction module is enabled to reduce a voltage applied to said processor.
54. The apparatus of Claim 53 wherein said power reduction module is enabled to reduce said voltage in response to said amount of time exceeding a selected amount of time.
55. The apparatus of Claim 54 wherein said power management module comprises a software routine.
56. The apparatus of Claim 55 wherein said first power consumption state is a sleep state.
57. The apparatus of Claim 56 wherein said reduced power consumption state is a power-off state.
58. An apparatus comprising:
a power management module to determine an amount of time a processor is in a first power consumption state, said first power consumption state comprising a period in which said processor is stopped;
a power reduction module to place said processor into a

reduced power consumption state in response to said amount of time said processor is in said first power consumption state, said power reduction module comprising a software routine, said power management module comprising a timer.

59. A system comprising:

a memory;

a processor coupled to said memory;

a power management module to detect an amount of time

said processor is in a first power consumption state,

said first power consumption state comprising a

period of time in which a clock of said processor is

stopped, said processor being placed into a reduced

power consumption state in response to said amount

of time said processor is in said first power

consumption state.

60. The system of Claim 59 wherein said reduced power consumption state comprises a reduced voltage state of said processor.

61. The system of Claim 60 wherein said reduced voltage state comprises a power-off state.

62. The system of Claim 61 wherein said power management module is enabled to determine a system idle time.
63. The system of Claim 62 wherein said system idle time is represented by said amount of time said processor is in said first power consumption state.
64. The system of Claim 63 wherein said first power consumption state is a sleep state.
- 65.(New) The system of Claim 64 wherein said power management module comprises a software routine.
66. The system of Claim 59 wherein said power management module comprises a software routine.
67. The system of Claim 59 wherein said power management module further comprises a timer.
68. The system of Claim 65 wherein said power management module further comprises a timer.

69. The system of Claim 59 further comprising
- a configurable device;
- power management software to power manage said configurable device.
70. The system of claim 69 further comprising:
- power management software to cooperate with said device manager to allow power management of a plurality of devices in the system which are configurable devices, and to manage a power level for each of the plurality of devices in the system. the power management software being capable of placing one or more of said plurality of devices in a reduced power consumption state.
71. The system of claim 70 further comprising a plug and play manager.
72. The system of claim 71 wherein said power management software is to communicate with said plug and play manager to update data structures if configuration changes occur to allow power management of dynamically reconfigurable devices.

73. The system of claim 72 wherein said power management software registers with said device manager to be notified of configuration changes.
74. The system of claim 73 wherein said power management software is to provide system level power management including the use of multiple system level power management states for said system, and to provide multiple power management states for said plurality of devices.
75. The system of claim 73 wherein said power management software is to provide support for idle detection for at least one of said plurality of devices.
76. The system of claim 73 wherein said power management software is to place the system in a sleep state when the system is idle and to keep said system in said sleep state until activity is detected, and wherein the sleep state is one of a plurality of system power management states, and further wherein said system stops a clock for a system processor in said sleep state.

77. A method comprising:
- determining an amount of time a clock of a processor is
stopped;
- placing said processor into a reduced power consumption
state in response to said amount of time said clock
of said processor is stopped.
78. The method of Claim 77 wherein said placing comprises reducing
a voltage of said processor.
79. The method of Claim 78 wherein said determining said amount of
time said clock of said processor is stopped contributes to
determining a system idle time.
80. The method of Claim 79 wherein said clock of said processor is
stopped when the processor is in a sleep state.
81. The method of Claim 80 wherein a timer is read to determine said
amount of time said processor is in a first power
consumption state.
82. The method of Claim 81 wherein said reduced power consumption
state is a power-off state.

83. The method of Claim 82 wherein reducing said voltage of said processor is performed in response to said amount of time said clock of said processor is stopped exceeding a selected amount of time.
84. The method of claim 83 further comprising power managing in cooperation with a device manager a plurality of devices in a system which are configurable devices; and managing a power level for each of the plurality of devices in the system, the power managing comprising placing one or more of said plurality of devices in a reduced power consumption state.
85. The method of claim 84 wherein said system comprises a plug and play manager.
86. The method of claim 85 wherein said power managing comprises communicating with said plug and play manager to update data structures if configuration changes occur to allow power management of dynamically reconfigurable devices.
87. The method of claim 86 further comprising registering power

management software with said device manager to be notified of configuration changes.

88. The system of claim 86 wherein said power managing comprises providing system level power management including the use of multiple system level power management states for said system, and to provide multiple power management states for said plurality of devices.
89. The method of claim 87 wherein said power managing comprises supporting idle detection for at least one of said plurality of devices.
90. The method of claim 87 wherein said power managing comprises placing the system in a sleep state when the system is idle and to keep said system in said sleep state until activity is detected, and wherein the sleep state is one of a plurality of system power management states, and further wherein said system stops a clock for a system processor in said sleep state.

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